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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,343	12/17/2004	Heinz Von Der Kammer	P67751US1	4112

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EXAMINER	
STANDLEY, STEVEN H	

ART UNIT	PAPER NUMBER
1649	

MAIL DATE	DELIVERY MODE
07/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/508,343	VON DER KAMMER ET AL.	
	Examiner	Art Unit	
	Steven H. Standley	1649	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-30* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

1. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s)1-11(in part), drawn to a method of diagnosing by measuring maguin-1, and a kit for diagnosing , including Maguin-1 Protein and DNA encoding it.

Group 2, claim(s)1-11(in part), drawn to a method of diagnosing by measuring maguin-2, and a kit for diagnosing, including Maguin-2 protein and DNA encoding it.

Group 3, claim(s)1-11(in part), drawn to a method of diagnosing by measuring maguin-1 AND maguin-2 together for diagnosis.

Group 4, claim 12(in part), drawn to a method of treating or preventing a neurodegenerative disease by administering an agent that affects the level of maguin-1 gene.

Group 5, claim 12(in part), drawn to a method of treating or preventing a neurodegenerative disease by administering an agent that affects the level of maguin-1 transcription product or fragment or variant.

Group 6, claim 12(in part), drawn to a method of treating or preventing a neurodegenerative disease by administering an agent that affects the level of maguin-1 translation product or fragment or variant.

Group 7, claim 12(in part), drawn to a method of treating or preventing a neurodegenerative disease by administering an agent that affects the level of maguin-1 translation product or fragment or variant.

Group 8, claim 12(in part), drawn to a method of treating or preventing a

neurodegenerative disease by administering an agent that affects the level of maguin-2 transcription product or fragment or variant.

Group 9, claim 12(in part), drawn to a method of treating or preventing a neurodegenerative disease by administering an agent that affects the level of maguin-2 translation product or fragment or variant.

Group 10, claim 12(in part), drawn to a method of treating or preventing a neurodegenerative disease by administering an agent that affects the level of maguin-2 translation product or fragment or variant.

Group 11, claim 13-15(in part), drawn to a modulator of activity of a maguin-1 gene or fragment of derivative or variant.

Group 12, claim 13-15(in part), drawn to a modulator of a maguin-1 transcription product or fragment of derivative or variant.

Group 13, claim 13-15(in part), drawn to a modulator of a maguin-1 translation product or fragment of derivative or variant.

Group 14 claim 13-15(in part), drawn to a modulator of activity of a maguin-2 gene or fragment of derivative or variant.

Group 15, claim 13-15(in part), drawn to a modulator of a maguin-2 transcription product or fragment of derivative or variant.

Group 16, claim 13-15(in part), drawn to a modulator of a maguin-2 translation product or fragment of derivative or variant.

Group 17, claim 13-15(in part), drawn to a modulator of activity of a maguin-1 and maguin-2 gene or fragment of derivative or variant.

Group 18, claim 13-15(in part), drawn to a modulator of activity of a maguin-1 and maguin-2 transcription product or fragment of derivative or variant.

Group 19, claim 13-15(in part), drawn to a modulator of activity of a maguin-1 and maguin-2 translation product or fragment of derivative or variant.

Group 20, claim 16-17(in part), drawn to a transgenic animal expressing an non-native human maguin-1 or fragment thereof.

Group 21, claim 16-17(in part), drawn to a transgenic animal expressing an non-native human maguin-2 or fragment thereof.

Group 22, claim 16-17(in part), drawn to a transgenic animal expressing an non-native human maguin-1 and maguin-2 or fragment thereof of either.

Group 23, claim 18-20(in part), drawn to an assay for screening a modulator using maguin-1.

Group 24, claim 18-20(in part), drawn to an assay for screening a modulator using maguin-2.

Group 25, claim 18-20(in part), drawn to an assay for screening a modulator using maguin-1 AND maguin-2 together.

Group 26, claim 21-23(in part), drawn to method of producing a medicament as it relates to maguin-1.

Group 27, claim 21-23(in part), drawn to method of producing a medicament as it relates to maguin-2.

Group 28, claim 21-23(in part), drawn to method of producing a medicament as it relates to maguin-1 AND maguin-2 together.

Group 29, claim 24-25(in part), drawn to a medicament as it relates to maguin-1.

Group 30, claim 24-25(in part), drawn to a medicament as it relates to maguin-2.

Group 31, claim 24-25(in part), drawn to a medicament as it relates to maguin-1 AND maguin-2 together.

Group 32, claim 26-27(in part), drawn to a protein of SEQ ID NO: 1 or fragment thereof.

Group 33, claim 26-27(in part), drawn to a protein of SEQ ID NO: 2 or fragment thereof.

Group 34, claim 28 and 30 (in part), drawn to an antibody to a protein of SEQ ID NO: 1 or fragment thereof.

Group 35, claim 29-30(in part), drawn to an antibody to a protein of SEQ ID NO: 2 or fragment thereof.

2. The inventions listed as Groups 1-35 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The first stated technical feature is a method of diagnosing a neurodegenerative disease. Group I includes said maguin-1 products, the corresponding nucleic acid, the first method of making it. There is no clear method of making. The remaining groups are drawn to different methods of using the products and methods. The product groups are drawn to distinct products that lack a special technical feature in common.

3. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

4. Any inquiry concerning this communication should be directed toward examiner Steven Standley (Ph: 571-272-3432). The examiner can normally be reached Monday through Friday from 8:00 AM to 4:30 PM. If attempts to reach the Steven Standley fail, the examiners' supervisor, Christina Chan, can be reached at (571 272-0841).

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (toll free) 866-217-9197.

Official papers filed by fax should be directed to (703) 872-9306 (before final rejection) or (703)872-9307 (after final). Faxed draft or informal communications with the examiner should be directed to ***571-273-0893.***

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID ROMEO/
PRIMARY EXAMINER
Art Unit 1647

Steven H. Standley, Ph.D.
6/21/07